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AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/011,634      04/03/98      ARONHIME      M      P16370

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IM22/0117

EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/011,634**

Applicant(s)  
**Aronhlme et al.**

Examiner  
**Grendzynski, Michael E.**

Art Unit  
**1774**



**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Oct 8, 1999

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 29-45 and 66-79 is/are pending in the applica

4a) Of the above, claim(s) 77-79 is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 29-45 and 66-76 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 29-45 and 66-79 are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) ☐ Notice of Informal Patent Application (PTO-152)

20) ☐ Other: \_\_\_\_\_

Art Unit: 1774

## **DETAILED ACTION**

### ***Preliminary Matters***

1. Applicants correctly pointed out that the Shinozaki reference intended was that of U.S. 5,631,119. The examiner inadvertently listed the patent's German counterpart as the reference number. Examiner apologizes for any inconvenience this may have caused.
2. This action vacates the action of January, 2001. This supplemental action is intended to clarify the standing of claims 66-76.

### ***Election/Restriction***

3. Newly submitted claims 77-79 are directed to an invention that lacks unity from the originally-filed claims, as indicated in prior two Office Actions (Paper Nos. 13 and 16), i.e., the special technical feature of the instant invention does not define a contribution over the prior art. *See* 37 C.F.R. 1.475.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 77-79 are withdrawn from consideration as being directed to a non-elected invention.

### ***Claim Rejections - 35 U.S.C. § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 29-45 and 66-76 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1774

Presently, the phrase "condensation-type" renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claim(s) unascertainable. *See* MPEP § 2173.05(d). What comprises condensation-type silicone? Examiner requests product information regarding the silicones used in the invention. The examiner considers this information material to the prosecution of the application.

With respect to claims 42 - 44, the exact composition of the release layer is unclear. Does the release layer comprise only a cross linker/catalyst/conductive material, or does it comprise a cross linker/catalyst/conductive material *and* the silicone? If the latter is the case, it is suggested that applicant use the language "further comprising" instead of the term "comprising."

With respect to claims 43 and 74 the metes of the bounds are not ascertainable. What is the value of "an amount greater than that normally used for the polymerization?" What is the value of the amount "normally used"? These phrases are neither defined in the specification, nor do they have a well-defined meaning in the art.

***Claim Rejections - 35 U.S.C. § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 29 is rejected under 35 U.S.C. 102(b) as being anticipated by Namiki. *See* Abstract.

Art Unit: 1774

***Response to Arguments***

8. Applicants' arguments filed 11/30/00 have been fully considered but they are not persuasive.

9. Claims 29-38 remain rejected under 35 U.S.C. 102(b) over Shinozaki (US 5631119) for the reasons of record. Applicants argue that a prima facie case of anticipation has not been established because Shinozaki does not provide an image transfer member suitable for the transfer of images. The phrase "suitable for the transfer of toner images from a first surface and transferring them to a second surface" is considered language of intended use, which is not dispositive of patentability. As such, applicants are claiming an article comprising a substrate with a condensation-cured silicone thereon. Shinozaki, for the reasons discussed in Paper No. 16, discloses such an article. Applicants also argue that the condensation silicone layer is removed during processing, such that the image transfer device has no silicone on it at all. Shinozaki discloses, however, that only the silicone located in the untyped areas is removed. Consequently, the article still comprises a base layer with a condensation-cured silicone thereon. The limitations of the claim are met by the disclosure of the reference.

***Claim Rejections - 35 U.S.C. § 103***

10. Claims 29-45 remain rejected--and newly-added claims 66-76 are rejected--under 35 U.S.C. 103(a) as being unpatentable over Hendrickson (4,600,673) for the reasons of record. Applicants argue that Hendrickson discloses an image forming member, not an image transfer member. Applicants are claiming an article comprising a base layer and an outer release layer comprising silicone. The phrase "suitable for the transfer of toner images from a first surface and transferring them to a second surface" is considered language of intended use, which is not dispositive of patentability. For the reasons discussed in Paper No. 16, Hendrickson discloses such an article. Additionally, images are, in fact, transferred from the Hendrickson

Art Unit: 1774

article to another substrate; consequently, the article acts as an image transfer member. Applicants further argue the Hendrickson silicone layer is "so thin . . . that they are described as at least partly transferred off the image forming member." This argument is not commensurate in scope with the claims. Applicants do not limit the thickness of the silicone layer of the instant invention. It is also important to note that partial transfer of the Hendrickson silicone layer occurs only when flash/pressure transfer is used on the Hendrickson article. In the other, thermal transfer method, no transfer of the silicone resin takes place. *See* col. 7, lines 44-60.

With respect to claims 66-70, the experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233.

With specific regard to claims 71-74, ethyl silicate is a known cross linker for condensation-cured silicones. Additionally, the examiner asserts that the final product would not contain any cross linking agent, i.e., that it would be used in its entirety during the cross linking of the silicone layer.

With specific regard to claim 75, carbon is a well-known electroconductive material in the electrophotographic art, and its use in an electrophotographic fixing roll would have been obvious to one of ordinary skill in the art at the time of the invention, motivated by the desire to improve the electroconductive properties of the layer.

With respect to claim 76, the phrase "is suitable for . . . further surface." is considered language of intended use, which is not dispositive on the issue of patentability.

11. Claims 29-45 and 66-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imai et al. (U.S. 4074001). Imai discloses a fixing roll comprising a substrate and a coating thereon, wherein the coating comprises a diorganopolysiloxane terminated at both chain ends with diorganohydroxysilyl groups. *See* col. 2, lines 3-5 and 46-50. This diorganopolysiloxane is a preferred example of a condensation-type silicone, as

Art Unit: 1774

indicated in the specification on p 22. It is also important to note that the phrase "suitable for the transfer of toner images from a first surface and transferring them to a second surface" is considered language of intended use, which is not dispositive of patentability.

With respect to claims 67-70, Imai discloses a thickness of the silicone layer within applicants' claimed range. *See* col. 5, lines 56-61.

With specific regard to claim 71, ethyl silicate is a known cross linker for condensation-cured silicones. Additionally, the examiner asserts that the final product would not contain any cross linking agent, i.e., that it would be used in its entirety during the cross linker of the silicone layer.

With specific regard to claims 72-74, The experimental modification of this prior art in order to ascertain optimum operating conditions (the weight percent of the ethyl silicate) fails to render applicant's claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233.

With specific regard to claim 75, carbon is a well-known electroconductive material in the electrophotographic art, and its use in an electrophotographic fixing roll would have been obvious to one of ordinary skill in the art at the time of the invention, motivated by the desire to improve the electroconductive properties of the layer.

With respect to claim 76, the phrase "is suitable for . . . further surface." is considered language of intended use, which is not dispositive on the issue of patentability.

#### ***Allowable Subject Matter***

12. Examiner would like indicate that none of Shinozaki, Namiki, Imai, or Hendrickson teach or suggest an image transfer member comprising, in order, a base layer, and toner receiving layer, wherein the toner-receiving layer comprises a diorganopolysiloxane terminated at both ends with diorganopolysiloxane groups,

Art Unit: 1774


said receiving layer having a thickness of from about 7  $\mu\text{m}$  to about 8  $\mu\text{m}$ . This indication is made subject to overcoming the rejections made under 35 U.S.C. §112.

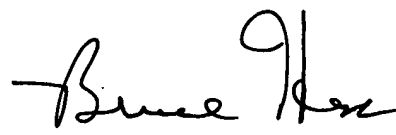
***Conclusion***

13. Should you have any questions concerning this communication, please direct them to Michael E. Grendzynski at telephone number (703) 305-0593. The examiner can be reached at this number from 7:00 a.m. to 3:30 p.m. Monday-Friday. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1774 are (703) 305-3599 for official after final faxes, and (703)305-5408 for all other official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.

  
Michael E. Grendzynski  
Assistant Examiner  
May 29, 2001

  
**BRUCE H. HESS**  
**PRIMARY EXAMINER**